

Serial No 09/976,443
In reply to Office Action mailed September 8, 2004
Page 6 of 8

REMARKS/ARGUMENTS

Claims 25-41 are pending in this application, and all of these claims have been rejected. Claims 25, 32, and 37 have been amended, and such amendments are fully supported by the specification. For at least the reasons stated below, Applicants assert that all claims are in condition for allowance.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 25-41 have been rejected under 35 U.S.C. § 102(e) as being unpatentable over *Moran* (U.S. Patent No. 6,430,542). Applicants respectfully oppose these rejections. The cited reference fails to teach each and every element of every claim as required by MPEP § 2131. For at least this reason, the Examiner's § 102 rejections are unsupported by the art and should be withdrawn.

(a) End User of the Present Claimed Invention is Distinct from End User of the System in Moran

As an initial matter, the present claimed invention is directed towards a method, system, and computer program for providing automated coaching for a financial modeling and counseling system over a network to a user, where the coaching is directed to the personal financial data, financial goals, and preferences of the user of the method, system, or computer program. As described in the specification, prior to the present invention, “[existing] systems tend to focus on the administrative aspects of financial planning without enabling the user to make reasoned choices about their financial futures. To do so the user needs a financial tool that approaches modeling from an executive decision-making perspective...Automated financial coaching would therefore reduce costs, and make financial advising more accessible to individuals of more modest means.” Specification, pages 1-2. These features of the present invention are reflected in the independent claims as discussed in more detail below.

In stark contrast, the system in *Moran* is not intended to be used directly by the user whose personal financial data, financial goals, and preferences are being processed or the end-user of the automated coaching advice; the person who interacts with the system of *Moran* is a financial advisor who counsels the owner of the financial portfolio. See Fig. 2; see also, Col. 1, lines 13-18 (“The present invention generally relates...to a computer-implemented program to

Serial No 09/976,443
In reply to Office Action mailed September 8, 2004
Page 7 of 8

assist financial advisors in performing financial simulations and other tasks for clients and prospective clients.”). A portfolio owner does not directly interact with the system of *Moran* as claimed in the present invention. Ultimately, the system of *Moran* merely assists a financial advisor in creating a financial advisory proposal to give to the portfolio owner. See Fig. 3.

This distinction renders *Moran* completely inapplicable to the present claimed invention. The independent claims recite inputting the user's financial data, financial goals, and preferences, and then, through various steps, providing automated financial coaching to that same user. Moreover, the user of the present claimed invention is explicitly not a financial advisor as taught in *Moran*. Rather, the term “financial coaching” as used herein this invention refers to coaching which may help a user consider a product, but never advises taking action on one. Such advice can only be dispensed by an accredited professional. See *Preliminary Amendment*, July 28, 2003.

Thus, whereas MPEP § 2131 requires for a valid § 102 rejection that “The identical invention must be shown in as complete detail as is contained in the ... claim,” the *Moran* reference clearly does not meet this standard. (emphasis added)

(b) *Moran* Fails to Describe Automated Financial Coaching Advice, Including Recommended Securities for the User to Purchase

Claims 25, 32, and 37 recite providing a user automated coaching advice, including recommended securities for the user to purchase. *Moran* fails to disclose these limitations.

The *Moran* reference discloses a computer-implemented financial planning and advice system for assisting financial advisors in performing financial simulations for clients. Abstract; Col. 1, lines 13-18; Col. 2, line 62-Col. 3, line 18. However, nowhere does *Moran* disclose recommending actual securities for a user to purchase as claimed. Indeed, the closest *Moran* comes to teaching the allocation of even assets in general is a high-level discussion of asset allocation analysis. For instance, *Moran* describes a recommendation summary, generated in part by a financial advisor, that generally recommends investing in equity mutual funds or in particular stock market certificates and curtly mentions an “asset allocation analysis.” Fig. 49; Col. 34, lines 10-24.

However, far from recommending actual securities for the user to purchase as claimed, this description of *Moran* is mere high-level portfolio advice, allocating assets among various

Serial No 09/976,443
In reply to Office Action mailed September 8, 2004
Page 8 of 8

general investment categories, e.g., bonds, mutual funds, stocks, cash, or real estate holdings. Moreover, the advice of *Moran* is provided to the portfolio owner by a financial advisor rather than the actual system described. Nowhere does *Moran* describe recommending securities to a user for that user to purchase.

For at least this reason, *Moran* fails to teach each and every element of every claim as required by MPEP § 2131.

CONCLUSION

Applicants submit that all pending claims are allowable and respectfully request that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7386.

If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Reference 60021-376002).

Respectfully submitted,

By 
Christopher R. Hilberg, Reg. No. 48,740
Customer No. 29838

Oppenheimer Wolff & Donnelly, LLP
45 South Seventh St.
Plaza VII, Suite 3300
Minneapolis, MN 55402-1609
Telephone: 612-607-7386
Facsimile: 612-607-7100
E-mail: CHilberg@oppenheimer.com